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9 Attorney for Plaintiff
10 CHRISTOPHER R. SCLIMENTI

FILED

2008 SEP 22 AM 11:41

**CLERK US DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

BY: W/IT DEPUTY

11 UNITED STATES DISTRICT COURT
12 FOR THE SOUTHERN DISTRICT OF CALIFORNIA
13 SAN DIEGO DIVISION

14 CHRISTOPHER R. SCLIMENTI, an individual
15 Plaintiff,

16 v.

17 THE LELAND STANFORD JUNIOR
18 UNIVERSITY, a California Corporation;
19 MICHELLE CALOS, an individual
20 Defendants.

08 CV 1730 W BLM
**COMPLAINT FOR (1) CORRECTION
OF INVENTORSHIP; AND (2) BREACH
OF CONTRACT**

VIA PDF

21 THE LELAND STANFORD JUNIOR UNIVERSITY ("STANFORD") has failed to
22 correct inventorship on U.S. Patents 6,808,925 and 7,141,426 to include Plaintiff as a rightful
23 inventor. STANFORD has further failed to pay Plaintiff royalties as provided by written contract
24 between STANFORD and Plaintiff. Accordingly, Plaintiff alleges and complains of Defendants
25 STANFORD and MICHELLE CALOS as follows:

PARTIES

- 26 1. Plaintiff CHRISTOPHER SCLIMENTI is an individual residing in San Diego
27 County, California.
28 2. Defendant STANFORD is a corporation organized and existing under the laws of
the State of California and has a principal place of business at Stanford University, Bldg. 10 Main

cf

1 Quad, Stanford, CA 94305. The designated agent for service of process for STANFORD is
2 Debra L. Zumwalt, Stanford Univ Bldg. 170 3rd Floor Main Quad, Stanford, CA 94305.

3 3. On information and belief, Defendant Michelle Calos is an individual residing in
4 San Mateo County, California.

5
6 **JURISDICTION AND VENUE**

7 4. This Court has personal jurisdiction over Defendant STANFORD under Fed. R.
8 Civ. P. 4(k)(1)(A) and California's long-arm statute, Cal. Civ. Proc. Code § 410.10, as Defendant
9 STANFORD is a California corporation, and has committed the complained-of acts in California,
10 thereby causing damage to Plaintiff in this judicial district.

11 5. This Court has personal jurisdiction over Defendant MICHELLE CALOS under
12 Fed. R. Civ. P. 4(k)(1)(A) and California's long-arm statute, Cal. Civ. Proc. Code § 410.10, as
13 Defendant MICHELE CALOS is a California resident.

14 6. This Court has subject matter jurisdiction over the correction of inventorship
15 pursuant to the patent laws of the United States, 35 U.S.C. §§ 1 et seq., and pursuant to 28 U.S.C.
16 § 1331 and 28 U.S.C. §1338(a).

17 7. Venue is proper in this district under 28 U.S.C. § 1391.

18
19 **BACKGROUND FACTS**

20 8. Plaintiff obtained his Doctor of Philosophy Degree from STANFORD in 2002.
21 While obtaining his degree, he invented, designed and performed experiments and other
22 scientifically valuable intellectual property in a laboratory run by Defendant MICHELLE
23 CALOS, who was employed by STANFORD.

24 9. Plaintiff entered into a contract during his tenure at STANFORD.

25 10. On February 12, 2001, Plaintiff and MICHELLE CALOS filed a patent
26 application naming them both as joint inventors. U.S. Patent Application 09/788,297 ("the '297
27 Application), published as U.S. 2002/0094516. Both Plaintiff and MICHELLE CALOS were
28 properly named in the '927 Application because they both conceived of the invention claimed.

1 11. Through subsequent prosecution before the United States Patent Office, Plaintiff
2 was removed from the '297 Application.

3 12. On April 29, 2004, MICELLE CALOS filed U.S. Patent Application 10/836,323
4 application naming herself as sole inventor. This application claims priority to the '297
5 Application as a continuation application.

6 13. On October 26, 2004, the '297 Application issued as U.S. Patent No. 6,808,925
7 ("the '925 Patent") naming as sole inventor MICHELLE CALOS. The sole assignee for this
8 patent is STANFORD.

9 14. On November 28, 2006, the '323 Application issued as U.S. Patent No. 7,141,426
10 ("the '426 Patent") naming as sole inventor MICHELLE CALOS. The sole assignee for this
11 patent is STANFORD.

12 15. Because Plaintiff jointly conceived of the inventions claimed in the '925 and '426
13 Patents, Plaintiff should be added as a co-inventor on these patents.

14 16. On information and belief, STANFORD has commercially exploited the technology
15 covered by the '925 and '426 Patents, receiving money and stock.

16 17. As part of the contract between Plaintiff and STANFORD, STANFORD was
17 obligated to pay a portion of the money and stock derived from an invention conceived of by
18 Plaintiff. To date, STANFORD has not provided any money or stock to Plaintiff.

19
20 **FIRST CAUSE OF ACTION**

21 **(Petition for Correction of Inventorship Under 35 USC 256)**

22 18. Plaintiff incorporates each of the preceding paragraphs as though the same were set
23 forth in full herein.

24 19. 35 USC 256 provides that a district court may "order correction of the patent on
25 notice and hearing of all parties concerned," "[w]henever through error a person is named in an
26 issued patent as the inventor, or through error an inventor is not named in an issued patent and
27 such error arose without any deceptive intention on his part...."

28 20. All the parties concerned are joined in this suit, and they comprise: STANFORD

1 (the assignee), MICHELLE CALOS (the sole named inventor) and Plaintiff (the omitted
2 inventor).

3 21. Conception is the touchstone of inventorship, the completion of the mental part of
4 invention. Sewall v. Walters, 21 F.3d 411, 415 (Fed. Cir. 1994).

5 22. Here, Plaintiff and MICHELLE CALOS jointly conceived of the invention claimed
6 in the '925 and '426 Patents, and therefore both are co-inventors on said patents.

7 23. The Court should issue an order directing the USPTO to correct the inventorship of
8 the '925 and '426 Patents to include the Plaintiff.

9
10 **SECOND CAUSE OF ACTION**

11 **(Breach of Contract)**

12 24. Plaintiff incorporates each of the preceding paragraphs as though the same were set
13 forth in full herein.

14 25. Plaintiff and STANFORD entered into a contract.

15 26. Plaintiff performed everything required under the contract.

16 27. STANFORD breached the contract by failing to provide Plaintiff his portion of the
17 money and stock derived from the inventions conceived of and consequently invented by
18 Plaintiff.

19 28. Plaintiff has been damaged by STANFORD's breach.

20
21 **PRAYER FOR RELIEF**

22 WHEREFORE, Plaintiff prays for judgment against Defendant as follows:

23 1. That Plaintiff is a co-inventor on the '925 and '426 Patents.

24 2. That Plaintiff be awarded damages as proven at trial, for STANFORD's breach of
25 contract;

26 ///

27 ///

1 3. For pre-judgment and post-judgment interest and costs of this action to Plaintiff
2 against Defendants; and

3 4. For such other and further relief as the Court deems just and proper.

4
5 DATED: September 22, 2008

Respectfully submitted,

6 THE LAW OFFICE OF
7 MANUEL DE LA CERRA

8
9  By: _____

10 Manuel de la Cerra
11 Attorney for Plaintiff
12 CHRISTOPHER R. SCLIMENTI
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DEMAND FOR JURY TRIAL

Plaintiff respectfully demands a trial by jury on all issues so triable.

DATED: September 22, 2008

Respectfully submitted,

THE LAW OFFICE OF
MANUEL DE LA CERRA

By: 

Manuel de la Cerra
Attorney for Plaintiff
CHRISTOPHER R. SCLIMENTI

JS 44 (Rev. 12/07)

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

Christopher R. Scimienti

(b) County of Residence of First Listed Plaintiff San Diego, CA

(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorney's (Firm Name, Address, and Telephone Number)

Manuel de la Cerra; 6885 Catamaran Drive; Carlsbad, CA 92011

DEFENDANTS

The Leland Stanford Junior University and Michelle Calos

County of Residence of First Listed Defendant

San Mateo, CA

(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE PROPERTY LAND INVOLVED.

Attorneys (If Known)

Not Known

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
- ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant
- ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business in This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business in Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	PERSONAL INJURY	PROPERTY	LABOR	OTHER
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	<input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury	<input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 <input type="checkbox"/> 820 Copyrights <input checked="" type="checkbox"/> 830 Patent <input type="checkbox"/> 840 Trademark	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes

V. ORIGIN

(Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
- ☐ 2 Removed from State Court
- ☐ 3 Remanded from Appellate Court
- ☐ 4 Reinstated or Reopened
- ☐ 5 Transferred from another district (specify)
- ☐ 6 Multidistrict Litigation
- ☐ 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):

35 USC Sec. 256

Brief description of cause: Correction of inventorship for Patent

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No

VIII. RELATED CASE(S) IF ANY

(See instructions):

JUDGE

DOCKET NUMBER

DATE

09/22/2008

SIGNATURE OF ATTORNEY OF RECORD

FOR OFFICE USE ONLY

RECEIPT # 155253

AMOUNT

\$350

APPLYING IFP

JUDGE

MAG. JUDGE

TAC 9/22/08

**UNITED STATES
DISTRICT COURT**
SOUTHERN DISTRICT OF CALIFORNIA
SAN DIEGO DIVISION

155253 - TC

**September 22, 2008
11:43:22**

Civ Fil Non-Pris

USAO #: 08CV1730
Judge.: THOMAS J WHELAN
Amount.: \$350.00 CK
Check#: BC8520

Photocopies

Qty....: 6 @ \$0.50
Amount.: \$3.00 CK
Check#: BC8520

Total-> \$353.00

FROM: SCLIMENTI
VS
LELAND STANFORD UNIVERSITY